



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Nancy DESGARDIN et al.

Group Art Unit: 3643

Application No.: 10/659,306

Examiner: Jeffrey L. Gellner

Filed: September 11, 2003

Docket No.: 117136

For: SOLID COMPOSITIONS WHICH GENERATE HYDROGEN BY COMBUSTION,
COMPRISING AN ALKALI METAL BOROHYDRIDE OR ALKALINE EARTH
METAL BOROHYDRIDE AND STRONTIUM NITRATE $\text{Sr}(\text{NO}_3)_2$

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 29, 2005 Restriction and Election of Species Requirement, Applicants provisionally elect Group I, claims 1-9 and 11-12 and Species A, sodium as the metal in borohydride, with traverse.

Regarding the restriction requirement, the Office Action states that claim 11 belongs to both Group I and Group II. Claim 11 is in a similar format as claim 12 because both claims comprise a composition and claim 12 depends from claim 11. Therefore, for purposes of this Response, claim 11 is treated as belonging solely to Group I.

The Office Action states that Groups II and I are related as process of making and product made. Applicants respectfully disagree. Group I and Group II are actually related as product made and process of using the product. In this regard, the claimed process (Group II) is a process for generating hydrogen using the claimed composition (Group I). As such, a restriction is only proper between product made and process of using the product when (1) the process of using the product as claimed can be practiced with another materially different

product or (2) the product as claimed can be used in a materially different process of using the product. Neither (1) nor (2) is asserted or demonstrated in the Office Action.

Additionally, where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claim of Group II include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Group II.

Because the method claim of Group II includes the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

It is also respectfully submitted that the subject matter of all claims and species is sufficiently related that a thorough search for the subject matter of any one Group of claims or species would encompass a search for the subject matter of the remaining claims or species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Regarding the election of species requirement, Applicants submit that claims 1-7, 9, and 11-12 are readable upon the elected species, and at least claims 1-6, 9, 11 and 12 are generic.

Applicants traverse the election of species requirement on the ground that the generic claims are not so broad as to place an undue burden on the Patent Office to search and examine the full scope of the claims. Rather, Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,



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